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Attorney Docket: 2055MC/48896
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	MOSHE SZYF ET AL.		
Serial No.:	09/554,414	Group Art Unit:	1652
Filed:	SEPTEMBER 6, 2000	Examiner:	M.WALICKA
Title:	DNA DEMETHYLASE, THERAPEUTIC AND DIAGNOSTIC USES THEREOF		

REPLY TO OFFICE ACTION

Commissioner for Patents
Washington, D.C. 20231

Sir:

Responsive to the Office Action mailed July 9, 2002 in the above-captioned application, applicants hereby provisionally elect the claims of Group XIII, namely claims 19-25, for examination in the instant application in the event the restriction requirement is not withdrawn.

This provisional election is made with traverse, and reconsideration and withdrawal of the requirement for restriction are respectfully requested.

According to the provisions of 37 C.F.R. §1.475, unity of invention must be determined on the basis of whether or not there is a "technical relationship among [the] inventions involving one or more of the same or corresponding special technical features." The restriction requirement is procedurally defective in that it does not discuss the presence or absence of "corresponding special technical features". On the contrary, the only discussion in the restriction requirement appears to relate to the standards of "independence" and "distinctness", which apply to regular U.S. utility applications. This is not, however, the proper standard for judging "unity of invention" in a PCT national stage application.

Moreover, the Office Action errs in stating that 37 C.F.R. §1.475 does not provide for multiple products or methods within a single application. 37 C.F.R. §1.475(c) states:

> "If an application contains claims to more or less than one of the combinations of categories of inventions set forth in paragraph (b) of this section, unity of invention **might** not be present." (emphasis supplied)

The use of the conditional word "might" in subparagraph (c) of Rule 475 clearly indicates that the presence of claims to more or less than one of the combinations recited in subsection (b) does not necessarily establish that unity of invention is not present. On the contrary, it might be present. Thus, it is possible to have unity of invention with multiple products or methods, so long as the claims all have corresponding special technical features.

Moreover, applicants submit that the claims do all have a corresponding special technical feature, namely they all relate to a DNA demethylase enzyme.

It is also instructive that neither the International Searching Authority, nor the International Preliminary Examining Authority, both of which are required to review and make a determination regarding the presence or absence of unity of invention, found unity of invention to be lacking. On the contrary, both the International Searching Authority and the International Preliminary Examining Authority, applying proper standards for determining unity of invention under the PCT, found unity of invention to be present.

Accordingly, the present Office Action, which fails to consider the proper standards for determining unity of invention and instead appears to apply standards not applicable to a PCT national stage application, is in error in requiring restriction of the application, and reconsideration and withdrawal of the restriction requirement are respectfully requested.

If there are any questions regarding this reply or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and

please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #2055MC/48896).

Respectfully submitted,

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